

REMARKS

Applicants submit this response to an Office Action mailed by the USPTO on October 14, 2005 (the "Office Action"). Filed concurrently herewith is a Request for Continued Examination ("RCE") by which applicants request further consideration of the present application. Upon entry of this amendment, claims 1-32 are pending in the present application; claims 3-7, 10, 13, 17-21, 25-27, 29 and 30 being withdrawn.

In the Office Action, the Examiner has objected to the drawings under 37 CFR 1.83(a) as failing to show a barrel having a tip, as recited by the claims. Applicants respectfully submit that reference number 220 of FIG. 2 is a tip (see also paragraph number [0032]), and that the amendment to claim 15 deletes reference to a barrel. Thus, applicants respectfully submit that the Examiner's objection to the drawings is obviated and further respectfully request withdrawal of that objection.

In the Office Action, the Examiner has made the following rejections of the claims:

Claims 1, 2, 8, 11, 12, 14-16, 22, 23 and 28 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,725,507 of Petrick;

Claims 1, 8, 11, 12, 14, 15, 22, 23 and 28 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,916,894 of Cloyd; and

Claims 9 and 24 under 35 U.S.C. §103(a) as being unpatentable over Petrick or Cloyd as applied to claims 1 and 20, and further in view of US Patent Application Publication No. US 2004/0097882 A1 of DiBiasi et al.

For the reasons set forth below, applicants respectfully traverse each of the above-noted rejections.

Before addressing the Examiner's rejections in detail, applicants take this opportunity to discuss the subject matter of the present invention - as they believe such discussion will assist the Examiner with further consideration of the present application. Applicants also believe the following discussion of the present invention will enable the Examiner to accurately consider the prior art references of record in the present application.

As recited by the claims of the present application, the subject invention is directed to "A tip cap for a syringe." See, e.g., claims 1 and 15. Applicants note that a "tip cap," as that term is used in the present application, is not just any device that is securable over a needle or tip of a syringe. Rather, and as clearly recited in paragraph [0008] of the present application, a tip cap is a device that is mounted over the tip of a pre-filled syringe (that does not have a needle), for the purpose of preventing contamination or loss of the medication contained within the syringe. Applicants believe that, when the claims of the present application are examined in this context, which, applicants respectfully submit is the proper context, the Examiner will agree with the points of distinction set forth below (similar points having been presented in applicants' response to the Office Action of May 17, 2005).

Petrick discloses a self-healing injection site that provides for self-healing of an injection site subsequent to puncture by a hypodermic needle. An "injection site," as that term is used by Petrick, refers to "self-sealing systems...[that] have particular application In implantable prosthetic devices." See, e.g., column 1, lines 14-18. Thus, the devices disclosed by Petrick are

implantable into the body of a patient. Once implanted, it may be necessary to inject a substance into the implanted device. In that case, it is necessary for the injection site to “self-heal” to prevent leakage of the injected substance from the implanted device. The Examiner refers to reference character 80 as teaching a tip cap having a non-circular cross-section. However, Petrick discloses that reference character 80 is a testicular prosthesis (column 7, lines 7-30), not a tip cap as claimed by applicants. In fact, applicants respectfully submit that Petrick provides neither teaching nor suggestion of a tip cap, and is thus not relevant prior art to the present application. Consequently, Petrick clearly fails to teach or suggest applicants’ invention, as recited by the claims of the present application. Applicants respectfully submit that their claims are not anticipated by Petrick, as it fails to teach or suggest each element recited by the claims of the present application, as is required of a proper 35 U.S.C. §102 reference. Consequently, applicants further respectfully submit that the Examiner’s rejection of claims 1, 2, 8, 11, 12, 14-16, 22, 23 and 28 under 35 U.S.C. §102(b) as being anticipated by Petrick is no longer tenable and respectfully request withdrawal of that rejection.

Cloyd also does not disclose a tip cap, as that term is used in the present application. The disclosure of Cloyd identified by the Examiner as a tip cap, reference character 12, is part of vial 11 that comprises the barrel of a syringe. See, e.g., column 1, lines 39-41. If a tip cap was to be used on the device disclosed by Cloyd, it would be placed on the tubular hub 16 to prevent contamination and leakage of the substance contained within the vial 11 (see, e.g., FIG. 1). Applicants respectfully submit that Cloyd neither teaches nor suggests such a tip cap. More specifically, Cloyd does not disclose a tip cap having a base portion with an upper surface and a

top wall with a non-circular cross-section when viewed at an angle substantially perpendicular to the upper surface, as claimed by applicants. The only disclosure on Cloyd about the cross-sectional shape of the disclosed device is that the device is cylindrical. See, e.g., column 1, lines 21-22. The Cloyd device (i.e., indicated by reference character 11) clearly must be cylindrical when viewed at an angle as described in applicants' claim 1, for example, in order for the vial 11 to rotatably mate with the syringe 1. Applicants respectfully submit that Cloyd does not teach or suggest a tip cap, as that term is used in the present application. Applicants further respectfully submit that, even if Cloyd discloses a tip cap (which applicants do not concede by making this point), it does not disclose a non-circular tip cap as recited by applicants' claims. Thus, applicants respectfully submit that their claims are not anticipated by Cloyd, as it fails to teach or suggest each element recited by the claims of the present application, as is required of a proper 35 U.S.C. §102 reference. Consequently, applicants further respectfully submit that the Examiner's rejection of claims 1, 8, 11, 12, 14, 15, 22, 23 and 28 under 35 U.S.C. §102(b) as being anticipated by Cloyd is no longer tenable and respectfully request withdrawal of that rejection.

DiBiasi et al. discloses a self-aligning shield for a syringe - the shield having a circular cross-section. See, e.g., FIG. 4. The above-noted deficiencies in the disclosure of each of Petrick and Cloyd are not overcome by the disclosure of DiBiasi et al., nor by the knowledge of a person of ordinary skill in the art. Thus, applicants respectfully submit that the Examiner's proposed combination of DiBiasi et al. and Petrick or Cloyd does not render the claims of the present application unpatentable. Applicants thus respectfully submit that the Examiner's

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rejection of claims 9 and 24 as being unpatentable over the combination of DiBiasi et al. and any of Petrick or Cloyd is no longer tenable, and respectfully request withdrawal of that rejection.


In view of the foregoing remarks, applicants respectfully submit that this amendment is fully responsive to the Office Action, and that claims 1, 2, 8, 9, 11, 12, 14-16, 22-24, 28, 31 and 32 are patentable over the prior art of record in the present application, and are thus in condition for allowance. Applicants thus respectfully request early and favorable reconsideration of the present application.

Applicant hereby authorizes the Commissioner to charge the fees necessary in connection with this amendment to Deposit Account Number 02-1666.

Any questions concerning this application or amendment may be directed to the undersigned agent of applicant.

Respectfully submitted,

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